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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,505	01/23/2004	Hajime Mizutani	110797.01	5227
25944	7590	05/12/2005	EXAMINER	
OLIFF & BERRIDGE, PLC			CADUGAN, ERICA E	
P.O. BOX 19928			ART UNIT	
ALEXANDRIA, VA 22320			PAPER NUMBER	

3722

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,505

Applicant(s)

MIZUTANI ET AL.

Examiner

Erica E Cadugan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 7-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/972,164.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/12/05 & 1/23/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group I, and the election therewithin of the species of Figure 13, in the reply filed on February 4, 2005 is acknowledged. The traversal is on the ground(s) that "the subject matter of all claims 1-20 is sufficiently related that a thorough search for the subject matter of any one species would encompass a search for the subject matter of the remaining species".

2. This is not found persuasive because, as set forth in MPEP sections 803 and 808.02, for example:

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP section 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant.

In the instant case, with respect to each of Groups I, II, III, and IV within claims 1-20, it is noted that Examiner provided the classification for each respective group, and noted that the groups "have acquired a separate status in the art as shown by their different classification". Thus, Examiner established a *prima facie* showing that examination of all groupings, i.e., all of claims 1-20, would place a substantial burden on the examiner, per the MPEP guidelines described above.

Applicant has not rebutted this *prima facie* showing by "appropriate showings or evidence" as required by the MPEP as described above, but instead, asserted that "the search and examination of the entire application could be made without serious burden" without any sort of

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such showings or evidence. Thus, for at least this reasoning, Examiner's *prima facie* showing has not been overcome.

Further, it is noted that the searches for the various groupings and species are not identical, and thus, in this regard, additionally, a serious burden would indeed be placed on the examiner to examine all claims 1-20.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 7-20 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention (re claims 12-20) and/or species (re claims 7-11), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/4/2005.

Additionally, Applicant has asserted that claim 1 is generic and reads on the elected embodiment of Figure 13. However, this assertion does not appear to be accurate. The embodiment of Figure 13 does not appear to show the "dimension measuring step" of measuring a dimension of the workpiece on the basis of the relative position of the cutting blade and workpiece upon their contact, so that such relative movement is controllable on the basis of the measured dimension of the workpiece, as set forth in claim 1, nor does there appear to be any teaching of using the embodiment of Figure 13 to perform such a step.

Accordingly, as it appears that claim 1 does not read on the elected embodiment of Figure 13, claim 1 is also withdrawn from consideration.

Thus, in summary, **claims 1 and 7-20 are hereby withdrawn from consideration** as being drawn to non-elected inventions and/or species.

### ***Specification***

4. The disclosure is objected to because of the following informalities: in the first sentence of the specification, as added by the preliminary amendment filed with the case, the status of the parent application should be updated (i.e., language such as --, now U.S. Pat. No. 6,758,640-- should be added at an appropriate location in the first sentence).

Appropriate correction is required.

### ***Claim Objections***

5. Claim 4 is objected to because of the following informalities: in the last line, it appears that "while" should be --and--. Appropriate correction is required.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 2-6 of the present application are rejected under the judicially created doctrine of double patenting over at least claims 1, 11, and 28, for example, of U. S. Patent No. 6,758,640.

Specifically, note that claim 2 of the present application is merely a slightly broader version of claim 1 of the patent, and that each element of the broader claims 3-6 of the present

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application is found in more specific claims 11 and 28 of the patent. Thus, the more specific claims of the patent serve to “anticipate” the broader claims of the present application.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by JP-63-283843 ('843).

'843 teaches a device including a “cutting blade” 2 and a workpiece 1 (see Figures 1, 3, abstract). Sensor 3 detects contact between the cutting blade 2 and the work 1 (Figures, abstract), and thus constitutes the claims “contact detecting device”.

Additionally, the numerical control device of the machine tool makes a determination on whether the blade and work on in contact (see abstract), and thus the part of the numerical control device responsible for that determination constitutes the claimed “contact determining device”.

In addition, the override controller 4 constitutes the claimed “checking device” in that it, as broadly claimed, “checks” if the blade and work are “in a normal condition” in which the “contact detecting device” 3 detects the contact between the blade and the work (abstract, figures).

10. Claims 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP-8-141804 ('804).

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'804 teaches a cutting blade 4 and/or 12 having a conductive layer 13 (see abstract and Figures 1-5). Additionally, '804 teaches an "object" 3 in the form of a workpiece. Note that blade 4/12 is held by a blade holding member 2 (Figure 1). Note also that '804 teaches a power source 21 (see Figure 1, for example). Note also that the layer 13 is located in the space between the blade 4/12 and the holder 2, and is also located between the blade 4/12 and the workpiece 3 (Figures 1-5, for example).

Note that as viewed in Figure 6, for example, resistance (from the circuit shown in Figure 1, which includes at least the holder 2, the blade 4/12, the workpiece 3 -- see Figure 1 and paragraph 0017, for example --, and the power source 21) is shown on the vertical left-hand axis, and cutting time is shown on the horizontal axis (see Figure 6, also paragraph 0028, for example). Note that such a circuit would inherently provide information about when the cutting tool was not in contact with the workpiece, as at such time, the resistance of the circuit would be infinite. Such circuit also detects contact of the tool with the workpiece, as viewed in Figure 6 (i.e., when the resistance is not infinite).

Re claim 6, see Figures 2-5, for example.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on M-F, 7:30 a.m. to 5:00 p.m., alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H. Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Erica E Cadogan  
Primary Examiner  
Art Unit 3722